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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,614	07/19/2000	Makoto Kukita	193236US2	2165

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EXAMINER

SHENG, TOM V

ART UNIT

PAPER NUMBER

2673

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/619,614

Applicant(s)

KUKITA, MAKOTO

Examiner

Tom V Sheng

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 8-11, and 15-16 rejected under 35 U.S.C. 102(b) as being anticipated by Young (US Patent 5382962).

Consider claims 1 and 8. Young teaches a handle/controller for a handheld computer (figures 1, 2, 3), comprising a main body (handheld computer 1 and base unit 2) having a display unit (see figure 1) on a surface thereof; and a holding unit (handle/controller 4) protruding from the main body and including a pointing device (cursor ball 5L or 5R) and switches (action switches 6L or 6R) configured to be operated by a same hand holding the holding unit (see column 1, line 60 - column 2, line 6).

As for claims 2 and 9, Young's cursor ball (5L or 5R) reads on claimed trackball pointing device configured to perform pointing operations including moving a cursor displayed on said display unit (see column 2, lines 10-16).

As for claims 3 and 10, Young's action switch (6L or 6R) reads on claimed said switches comprises click devices configured to set or cancel instructions pointed to by said pointing device (see column 2, lines 17-19).

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As for claims 4 and 11, Young's handle/controller 4 is detachable and thus reads on claimed said holding unit is removable from main body (see column 2, lines 20-30).

As for claims 15 and 16, Young's handle/controller 4 is for a handheld computer that reads on claimed portable computer.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young.

As for claims 5 and 12, Young is silent regarding claimed said holding unit is configured to store batteries used to power said portable electronic apparatus. On the other hand, Young teaches batteries storage in side legs 3, inherently for powering his handheld computer in the field. One of ordinary skill in the art would recognize that the batteries could just as easily be installed in the handle/controller 4; moreover, with the batteries in the handle/controller 4, the user would have a more balanced feel holding the computer. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate batteries into the handle/controller, thus providing batteries powered operation in the field and with good balance holding the computer.

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5. Claims 6, 7, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young as applied to claims 1 and 8 above, and further in view of Hartigan (US Patent 6035491)

Consider claims 6, 7, 13, and 14. Young teaches a holding unit including a pointing device and switches operable by a same hand. However, Young does not teach that the holding unit is foldable toward a side of the main body, or that power would be supplied/cut-off based on the position of the holding unit. On the other hand, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Young's holding unit to be foldable and further having power-on when unit is unfolded and power-off when unit is folded, since some people would prefer to hold the holding unit in an upright fashion when operating the portable electronic apparatus. Further, it would be naturally desired to turn off the apparatus when the holding unit is folded, since the user is not going to use the apparatus in that instance.

As a support, Hartigan shows a foldable device (10) having a flip portion (14) housing a display (18). Naturally, when the flip portion is open, the user is intending to use the device, and when the flip portion is closed, the user is not going to use the device (column 2, lines 1-37). This is similarly true with a foldable cell phone.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-4, 6, 8-11, and 13 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

TS  
October 17, 2002

  
KENT CHANG  
PRIMARY EXAMINER